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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Cheryl M. Tyus

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07/17/2006

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EXAMINER

PORTER, RACHEL L

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/963,694	<b>Applicant(s)</b> TYUS, CHERYL M.	
	<b>Examiner</b> Rachel L. Porter	<b>Art Unit</b> 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the application filed 4/25/06. Claims 1-9 are pending. Claim 9 is new.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 7 have been amended to recite: "transmitting aggregate data from multiple patients for use by research, teaching and healthcare institutions" and "means for storing data in a centralized archival searchable database accessible in aggregate by the research, teaching and healthcare institutions."

Claim 2 has been amended to recite: "searching the centralized archival database for selected data from multiple patient files according to a desired criteria" (*sic*).

In particular, it is noted that the applicant has pointed to areas of the specification which are intended to provide support for these new features. However, the Examiner was the Examiner unable to find support for this newly added claim language within these passages of the specification. As such, the Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims, or to cancel the new matter in the reply to this Office Action.

Claims 2-6 and 8-9 inherit the deficiencies of claims 1 and 7 through dependency and are also rejected.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,2,5, and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans (USPN 5,924,074).

[claim 1] Evans discloses a system for a system for capturing, archiving and transmitting medical images and their associated data (i.e. aggregate data) from multiple patients, the system comprising:

- means for generating medical data from multiple patients (col.5,lines 10-21), said medical data comprising both image data and textual data; (col. 5, lines 1-20; col. 6, lines, 1-5, Figures 13-14)

- means for capturing the medical data, said capturing means comprising a software program and computer; (Figure 4, col. 6, line 10-col. 7, line 40—capture software and computer)
- means for storing the data in a centralized archival searchable database accessible in the aggregate by research, teaching and healthcare institutions; and (col. 8, line 19-col. 9, line 9, line 3—patient record, patient repository, and legacy system; Figure 24, col. 12, lines 56-col. 13, line 30 data is available and searchable to teaching/research/healthcare institutions; col. 13, lines 57-col. 14, line 14—allows the system users to access the relational database included within the EMR system )
- means for transmitting the data to a user. (Figure 15a; col. 9, lines 17-37; line 41-col. 10, line 35)

[claim 2] Evans discloses a system further comprising means for searching the centralized archival database for selected data from multiple data patient files according to desired criteria. (col. 10, lines 18-30; Figure 15 A; col. 4, line 64-col. 5, line 25 )

[claim 5] Evans discloses the system of claim 1 wherein the storage means is selected from the group consisting of a hard drive, floppy drive, a removable storage system, an optical storage system, a CD drive, a networked drive internal to the user, an array of drives, and a networked drive accessible via the Internet. (col. 8, line 19-col. 9, line 9, line 3; col. 12, line 56- col. 13, line 56; Figure 24)

[claim 7] Evans teaches a method of capturing and archiving medical data (i.e. aggregate data) from multiple patients comprising the steps of:

- generating medical data from multiple patients (col.5,lines 10-21), using one or more input devices, said medical data comprising both image and textual data; (col. 5, lines 1-20; col. 6, lines, 1-5, Figures 13-14)
- capturing the medical data from the input devices; (Figure 4, col. 6, line 10-col. 7, line 40—capture software and computer)
- storing the medical data in centralized archival searchable database accessible in the aggregate by research, teaching and healthcare institutions that permits an institution to document an audit trail; and (col. 8, line 19-col. 9, line 9, line 3; — patient record, repository, and legacy system; col. 14, lines 43-50—audit trail; Figure 24, col. 12, lines 56-col. 13, line 30 data is available and searchable to teaching/research/healthcare institutions; col. 13, lines 57-col. 14, line 14—allows the system users to access the relational database included within the EMR system)
- transmitting the medical data on demand to a user. (Figure 15a; col. 9, lines 17-37; line 41-col. 10, line 35)

[claim 8] Evans discloses the method of claim 7 wherein the medical data comprises imaging data, textual data and audio data. (Figure 14; col. 5, lines 1-28; col. 8, line 61-col. 9, line 14)

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[claim 9] Evans discloses the system of claim 2 further comprising means for producing user-defined reports for display or printing. (Figure 24; col. 12, lines 56-col. 13, line 41—system includes peripherals such as printers and monitors)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans as applied to claim 1 above, and in view of Shipp (USPN 6,031,526).

[claim 3] Evans teaches a system wherein the medical data further comprises audio input (Evans: Figure 14; col. 8, line 65-col. 9, line 4—audio input), but does not expressly disclose that the system includes a voice recognition component. Shipp discloses a system for generating medical data that includes a voice recognition component. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans with the teaching of Shipp to include a voice recognition component. As suggested by Shipp, one would have been motivated to include this feature to allow a physician to automatically create a readable text record generated from his/her comments while performing a procedure on a patient. (col. 1, line 65- col. 2, line 2)

[claim 4] Evans discloses the system of claim 3 further comprising a system audio component to enable a user to store the audio input directly into the archive in a report format. (Evans: Figure 14; col. 8, line 65-col. 9, line 4)

8. Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evans as applied to claim 1 above, and in view of Douglas et al (USPN 6,039,688)

[claim 6] Evans discloses the system of claim 1 and further discloses that the system use of a plurality of wireless and wired connections. (Figure 24) However, Evans does not expressly disclose that the system includes a videoconferencing feature. Douglas discloses a system further comprising a videoconferencing component to enable the user to provide healthcare services over distance utilizing a wired or wireless connection. (Figures 47-48; col. 19, lines 10-26) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans with the teaching of Douglas to include a videoconferencing feature. One would have been motivated to include this feature to facilitate real-time collaboration and consultation among patients and healthcare providers (See Evans: col. 2, lines 45-62).

### ***Response to Arguments***

9. Applicant's arguments filed 4/25/06 have been fully considered but they are not persuasive.



(A) Applicant argues that the claimed invention distinguishes over the prior art because allows multiple patients to be searched at once, while the prior art only allows retrieval based upon patient ID.

In response, the Examiner respectfully disagrees with the Applicant's interpretation and the position that the querying of data by patient ID limits the number or the amount of information that may be retrieved. Evans states that the system may be used to retrieve data for a plurality of patients as the physician makes his/her rounds (col. 5, lines 10-21).

Moreover, the examiner has provided additional citations from the prior art to address the newly added limitations, for applicant's consideration.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

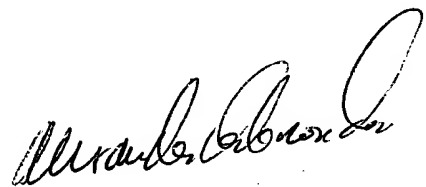
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ALEXANDER KALINOWSKI  
SUPERVISORY PATENT EXAMINER